FULBRIGHT & JAWORSKI L.L.P.

RECEIVED
CENTRAL FAX CENTER

A REGISTERED LIMITED LIABILITY PARTNERSHIP 600 CONGRESS AVENUE, SUITE 2400 AUSTIN, TEXAS 76701-3271 WWW.FULBRIGHT.COM

FEB 1 8 2005

10100700

20

A1083

FACSIMILE TRANSMISSION

| RECIPIENT(S): | FAX No.: | PHONE NO.: | |
|------------------------------------|--------------|------------|--|
| William R. Dixon USPTO, TC 1600 | 571-273-8300 | | |

| FROM: | David L. Parker | FLOOR: |
|-------|-----------------|--------|
| | | |

PHONE: (512) 536-3055 FAX: (512) 536-4598

RE:

Number of Pages Including Cover Page: 4

| Message: | | | |
|----------|---|------|------|
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | • | | |

CAUTION - CONFIDENTIAL

THE INFORMATION CONTAINED IN THIS FACSIMILE IS CONFIDENTIAL AND MAY ALSO CONTAIN PRIVILEGED ATTORNEY-CLIENT INFORMATION OR WORK PRODUCT. THE INFORMATION IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHOM IT IS ADDRESSED. IF YOU ARE NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE TO DELIVER IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY USE, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THE FACSIMILE IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE, AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

IF YOU DO NOT RECEIVE ALL OF THE PAGES, PLEASE CALL LORI DEE AT (512) 536-3073 AS SOON AS POSSIBLE.

FEB 1 8 2005

FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP 600 CONGRESS AVENUE, SUITE 2400 AUSTIN, TEXAS 78701-3271 WWW, FULBRIGHT, COM

DAVID L. PARKER PARTNER DPARKER@FULBRIGHT.COM DIRECT DIAL:

(512) 536-3055

TELEPHONE:

(512) 474-5201

FACSIMILE:

(512) 536-4598

February 18, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. § 1.8

I hereby certify that this correspondence is being transmitted to: Commissioner for Patents, P. O. Bex 1450; Alexandria, VA. 22313, Atm: William R. Olxon, TC 1600, facsimile number (5%) 273-8300 in the date below:

February 18, 2005 Date

Commissioner for Patents P. O. Box 1450 Alexandria, VA 22313-1450

SN 09/982,113 entitled "A METHOD TO INCORPORATE N-(4-

HYDROXYPHENYL) RETINAMIDE IN LIPOSOMES" by Lopez-Berestein et al.

Our ref: UTSC:660US Client ref: MDA00-030

Commissioner:

Enclosed for filing in the above-referenced patent application is a Request for Reconsideration of Decision on Petition to Group Director Pursuant to 37 C.F.R. §§1.127 and 1.181.

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/UTSC:660US

> David L. Parker Reg. No. 32,165

DLP/ld Enclosures

25504675.1 / 10101.798

David L. Parker

RECEIVED CENTRAL FAX CENTEP

FEB 1 8 2005

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. § 1.8

I hereby certify that this correspondence is being transmitted to: Commissioner for Patents, P. O. Box 1450 Articandria, VA 22313, Attn: William R. Dixon, TC 1600, factimile number 1571) 273-3300 on the date

below:

February 18, 2005

Date

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lopez-Berestein et al.

Serial No.: 09/982,113

Filed: October 17, 2001

For: A METHOD TO INCORPORATE N-(4-

HYDROXYPHENYL) RETINAMIDE IN

LIPOSOMES

Group Art Unit: 1615

Examiner: Kishore, Gollamudi S.

Atty. Dkt. No.: UTSC:660US

REQUEST FOR RECONSIDERATION OF DECISION ON PETITION TO GROUP DIRECTOR PURSUANT TO 37 C.F.R §§1.127 AND 1.181

Commissioner for Patents P. O. Box 1450 Alexandria, VA 22313-1450

Commissioner:

Appellants hereby request reconsideration of the Petition Decision of the group director in the referenced matter, mailed January 26, 2005, for the reasons detailed below.

In the subject decision, the Group Director reviewed the background facts, and concluded that the Examiner's refusal to enter the amendment to base claim 54 was proper. In arriving at this decision, the Group Director found that the amendment to claim 54:

...would have been proper if it were not that dependent claim 141 states that the "lipid material comprises DMPC, SO and water". Claim 141 clearly adds material not found in claim 54, thus raising a consideration under 35 U.S.C. 112, second paragraph.

However, the Group Director is requested to observe that claim 141 was already of record in this case and has been under active examination since November, 2003. So claim 141 itself cannot raise an issue under section 112, second paragraph as it has been considered by the examiner previously and presumably found to be free of section 112 second paragraph concerns (or at least none were previously raised).

Stating the situation another way, Appellants attempted to narrow the scope of claim 54 after final by limiting claim 54 to cover the subject matter of previous claim 138 – wherein the lipid material comprises elements A and B – and claim 138 was canceled. The Group Director apparently agreed that this was appropriate except for the presence of claim 141 – which was directed to the lipid material comprising elements A, B and C – in other words, pre-existing claim 141 was a further narrowing of claim 54. However, since claim 141 has been in the case and under active examination for some time it cannot raise "new" section 112, second paragraph concerns.

Accordingly, the Group Director is requested to instruct the Examiner to enter the amendment after final and proceed with the current appeal based on the claims following such amendment.

Respectfully submitted,

David L. Parker

Reg. No. 32,165 Attorncy for Applicants

FULBRIGHT & JAWORSKI L.L.P. 600 Congress Avenue, Suite 2400 Austin, Tex: 78701 (512) 536-5:201 (512) 536-4:598 (facsimile)

Date:

February 18, 2005